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10/587,565	07/31/2006	Petrus Karsten	016915-0287	2337
22428 7590 12/09/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
MULLS, JEFFREY C				
ART UNIT		PAPER NUMBER		
1796				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/587,565

**Applicant(s)**

KARSTEN ET AL.

**Examiner**

Jeffrey C. Mullis

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The numbers "about 4" and 19 do not appear in the specification as filed and claim 15 therefore contains new matter.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "vinylisoprene" is unclear in that isoprene has several possible points of attachment where substituents can be placed and it is therefore unclear where the vinyl moiety is on the isoprene.

Haze may be internal or other than internal and dependent on method of measurement and since these factors are not stated, claim 15 is unclear.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang et al. (US 2004/0127614).

Jiang discloses an article having an olefin polymer with greater than 40% crystallinity (Abstract) which may include syndiotactic polypropylene (spp) at paragraph 297 and which may contains styrene butadiene/isoprene styrene block copolymer (paragraph 456) and ethylene methyl acrylate copolymer (paragraph 460) and in which the article may be tubular (paragraph 663) or formed into a bag (paragraph 512). With regard to applicants haze value, the composition is said to be transparent in the footnote to Table 45 and at paragraph 44 and therefore would have no haze.

There are no examples in which all of applicants features are present in combination simultaneously. However to arrive at such would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

Claims 1-3, 5, 10 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ajbani et al. (US 2004/0151933).

The reference discloses a composition containing a component "c" which may be a styrene-isoprene/butadiene-styrene block copolymer and a "thermoplastic resin" (Abstract) which may include spp (paragraph 25). Ethylene methylacrylate may be

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added in paragraph 56. Note claim 24 where the material is used as an adhesive to overmold on a substrate.

There are no examples in which all of applicants features are present in combination simultaneously. However to arrive at such would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

Claims 1-3 and 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Morizono et al. (US 2003/0049477).

Patentees disclose a composition requiring spp (abstract) and which may contain a styrene butadiene/isoprene block copolymer (paragraph 353). The material may be used to form tubes (paragraph 770) or laminates (paragraph 754). With regard to applicants haze value, the composition is said to exhibit transparency in the Abstract and therefore would have no haze.

The declaration under 37 CFR 1.132 filed 7-28-08 is insufficient to overcome the rejection of claims rejected above based upon the art cited above as set forth in the last Office action because: the term "vinylisoprene" implies a vinyl unit attached to an isoprene unit and the unit shown on page 2 only shows an isoprene unit and not only is no vinyl unit (as the term is used in the art) attached to the isoprene unit, none is even contained therein. The rejection under 35 USC 112 second paragraph is therefore maintained. Since the units shown in item 10 are not vinylisoprene units such as are present in "elastomer 1", applicants are relying on limitations not present in the claims.

Furthermore, even if the claims were limited to block copolymers containing unit 10 applicants own published specification at paragraph 8 indicated that such microstructure is present with "polyisoprene" units (apparently the results of 1,4 addition but this is unclear) and given that use of microstructural control agents such as polar modifiers when polymerizing butadiene is not known to be entirely effective in producing 100% 1,4 addition it appears very unlikely that 100% 3,4 units (such as are shown in applicants item 10) are present, apparently consistent with paragraph 8 of applicants specification implying a mixture of unit types. Furthermore it does not appear likely that 100% units resulting from 1,4 addition are present in supposedly comparative elastomer 3 although applicants have failed to provide information in this regard as is their burden. However the claims in no way, no matter how interpreted can be said to encompass a particular concentration of one isoprene microstructure as no numerical data at all is present in the claims regarding particular types of units. Lastly, the effect of crystallinity on haze is known (see Oi, Seta, Schiavone, and Hori at paragraphs 23, 118, 58 and 27 respectively in this regard) and hydrogenated poly (1,4 butadiene), i.e. polyethylene, would certainly be expected to be more crystalline than the other elastomers in applicants declaration.

Applicant's arguments filed 7-28-08 have been fully considered but they are not persuasive. The defects in applicants declaration are set out above and applicants are referred to the above remarks for arguments pertinent to the declaration.

It is not clear why Jiang would disclose that one catalyst should be capable of producing syndiotactic polypropylene if no syndiotactic polypropylene was to be produced. Such polymer is disclosed to be blendable with various elastomers at paragraph 456 including those of applicants and hence there is ample motivation to blend the spp with applicants thermoplastic elastomers to obtain results desired by Jiang. There is nothing in the instant claims excluding adhesive properties even if the claims were limited to multilayer structures, adhesives are commonly used to produce such.

It is not the position of the examiner that Ajbani discloses applicants invention since no rejection under 35 USC 102 has been made.

Applicants appear to argue that there are a large number of embodiments in Morizono not reading on applicants claims. However such a fact is immaterial to anticipation. There is no limit to the number of embodiments a reference may have so long as one reads on the claimed invention.

Note Ex parte A 17 USPQ 2d at page 1718 where it was held "Even if the number of compounds disclosed in the reference were several orders of magnitude greater, we would come to the same conclusion. The 10th edition of the *Merck Index* lists 10,000 compounds. In our view each and every one of those compounds is 'described,' as a term is used in 35 U.S.C. § 102(a), in that publication. A similar conclusion would be appropriate with respect to the approximately 1.5 million compounds disclosed by the Beilstein Handbook (*Handbuch der Organischen Chemie*). As a general principle it has long been held, even where the issue was one of

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obviousness and not clear anticipation or description, that the comprehensiveness of a reference disclosure does not derogate from its teaching effect. *Merck Co. v. Biocraft Laboratories, Inc.*, -- F. 2d --, 10 USPQ2d 1843 (Fed. Cir. 1989); *In re Corkill*, 771 F. 2d 1496, 226 USPQ 105 (Fed. Cir. 1985); *In re Susi*, 58 CCPA 1074, 440 F. 2D 442, 169 USPQ 423 (1971); *In re Lemin*, 51 CCPA 1404, 332 F. 2D 839, 141 USPQ 814 (CCPA 1964); *In re Rosicky*, 276 F. 2d 656, 125 USPQ 341 (CCPA 1960).



With regard to the numerous other precedents discussed by appellants, they invariably deal with a significantly different set of facts. In each case to arrive at the claimed subject matter, it was necessary to select portions of that subject matter from the various sections of the reference disclosure and combine them, e.g., selecting values for variable substituents to interpolate into a generic structural formula to arrive at a specific compound. Even in those cases if the classes were sufficiently limited or well delineated, anticipation was found . . . Of course it goes without saying (but equally of course we are going to say it) that the evidence of asserted unobvious results of record is not relevant to this rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis  
at telephone number 571 272 1075.

Jeffrey C. Mullis  
Primary Examiner  
Art Unit 1796

JCM

11-11-08

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796